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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/532,263

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EXAMINER

COLEMAN, BRENDA LIBBY

ART UNIT

PAPER NUMBER

1624

MAIL DATE

DELIVERY MODE

11/26/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/532,263	Applicant(s) MONSE ET AL.	
	Examiner Brenda L. Coleman	Art Unit 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/12/05</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claims 1-10 are pending in the application.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 7-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In evaluating the enablement question, several factors are to be considered. *In re Wands*, 8 USPQ2d 1400 (Fed. Cir. 1988); *Ex parte Forman*, 230 USPQ 546. The factors include: 1) The nature of the invention, 2) the state of the prior art, 3) the predictability or lack thereof in the art, 4) the amount of direction or guidance present, 5) the presence or absence of working examples, 6) the breadth of the claims, and 7) the quantity of experimentation needed.

HOW TO USE: The scope of “neurodegenerative diseases”, “neurotraumatic injuries” or “malignant diseases” cannot be deemed enabled. The notion that a compound could be effective against neurodegenerative diseases, neurotraumatic injuries or malignant diseases in general is contrary to our current understanding of how pharmacologicals work. All attempts to find a pharmaceutical to treat

Art Unit: 1624

neurodegenerative diseases, neurotraumatic injuries or malignant diseases generally have thus failed.

In view of the lack of direction provided in the specification regarding starting materials, the lack of working examples, and the general unpredictability of chemical reactions, it would take an undue amount of experimentation for one skilled in the art to make the claimed compounds and therefore practice the invention. To be enabling, the specification of a patent must teach those skilled in the art how to make and use the scope of the claimed invention without undue experimentation. The applicants' are not entitled to preempt the efforts of others. The test for determining compliance with 35 U.S.C. § 112, is whether the applicants have clearly defined their invention.

Additionally, the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims where the compounds of formula I are used to inhibit extracellular signal regulated kinase 2, protein kinase A, protein kinase C and glycogen-synthase-kinase 3 β , in addition to the treatment of a magnitude of neurodegenerative diseases, neurotraumatic injuries, etc., the claims also include the treatment of malignant diseases. Evidence involving a single compound and two types of cancer was not found sufficient to establish the enablement of claims directed to a method of treating seven types of cancer with members of a class of several compounds In re Buting 163 USPQ 689. The remarkable advances in chemotherapy have seen the development of specific compounds to treat specific types of cancer. The great diversity of diseases falling within the "tumor" category means that it is

Art Unit: 1624

contrary to medical understanding that any agent (let alone a genus of thousands of compounds) could be generally effective against such diseases. The intractability of these disorders is clear evidence that the skill level in this art is low relative to the difficulty of the task.

Where the utility is unusual or difficult to treat or speculative, the examiner has authority to require evidence that tests relied upon are reasonably predictive of in vivo efficacy by those skilled in the art. See *In re Ruskin*, 148 USPQ 221; *Ex parte Jovanovics*, 211 USPQ 907; MPEP 2164.05(a).

Patent Protection is granted in return for an enabling disclosure of an invention, not for vague intimations of general ideas that may or may not be workable. Tossing out the mere germ of an idea does not constitute enabling disclosure. *Genentech Inc. v. Novo Nordisk* 42 USPQ2d 1001.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

a. Claims 1, 2, 5 and claims dependent thereon are vague and indefinite in that it is not known what is meant by "general formula (I)", "general formula (IA)" and "general formula (IB)". A formula is not general when all of the variables are defined. Deletion of "general" is suggested.

Art Unit: 1624

b. Regarding claim 1, the phrase "e.g." renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

c. Claim 1 and claims dependent thereon are vague and indefinite in that it is not known what is meant by "may join together to form N₃" in the definition of R₁₃ or R₁₄.

d. Claim 2 is vague and indefinite in that it is not known what is meant by R₁ to R₁₂. It is believed that the applicants' intended R₁, R₂, R₃, R₄, R₅, R₆, R₇, R₈, R₉, R₁₀, R₁₁ and R₁₂.

e. Claim 5 is vague and indefinite in that it is not known what is meant by R₁ to R₇ and R₁₂. It is believed that the applicants' intended R₁, R₂, R₃, R₄, R₅, R₆, R₇ and R₁₂.

f. Claims 7, 8 and 10 provides for the use of the compounds according to any one of claims 1 to 6, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

g. Regarding claim 10, the phrase "for example" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Art Unit: 1624

h. Regarding claim 10, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 7, 8 and 10 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Objections

4. Claims 4-10 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend another multiple dependent claim. See MPEP § 608.01(n).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda L. Coleman whose telephone number is 571-272-0665. The examiner can normally be reached on 9:30-6:00.

Art Unit: 1624

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brenda L. Coleman/
Primary Examiner, Art Unit 1624